

## **REMARKS**

### **Overview**

Claims 84-89, 92-94, 98-100, 102-103, 105, 108 and 110 are pending in this application. Claims 84, 92, 98-100, 102-103 and 105 have been amended. Claims 95-97, 106-107, 109 and 111 have been cancelled. The present response is an earnest effort to place all claims in proper form for immediate allowance. Reconsideration and passage to issuance is therefore respectfully requested.

### **Interview Summary**

The Applicant, Dr. Boesen, and the undersigned attorney gratefully acknowledge the courtesy extended during the telephonic interview of September 13, 2006. The Interview Summary has been reviewed and is accurate and complete. The undersigned attorney, Natalie Pass, and Joe Thomas, were present. No agreement as to allowability was reached. The Goltra reference was discussed, in particular with respect to claim 84. It was discussed that additional claim limitations may help to distinguish the cited prior art.

### **Issues Under 35 U.S.C. § 112**

Claims 109 and 111 have been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, has possession of the claimed subject matter. In particular, the Examiner indicates that there is not support for "an evaluation and management code" as disclosed in claims 109 and 111. Applicant respectfully disagrees as there is clear support. In particular, Figure 12 clearly

describes the procedures as "E/M" which as one skilled in the art familiar with CPT codes would understand is a shortened form for "evaluation and management." Therefore, there is no new matter. However, in order to simplify issues in the case, claims 109 and 111 have been cancelled, thereby mooting these rejections.

### **Issues Under 35 U.S.C. 103**

Claims 84, 88-89, 94-100, 102-103, and 110-111 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,393,404 to Waters et al., in view of U.S. Patent No. 5,325,293 to Dorne and further in view of U.S. Patent No. 5,823, 949 to Goltra. These rejections are respectfully traversed.

Claim 84 has been amended in several ways. First, claim 84 has been amended to specify that the selection is "a plurality of diagnosis codes". In addition, claim 84 has been amended to require "providing a user interface adapted for ranking the plurality of diagnosis codes linked with the patient procedure code in a user defined rank order by allowing the order of codes to be changed by the user by highlighting one of the codes and then moving the highlighted one of the codes either up or down". These amendments further distinguish claim 84 from the cited prior art.

Goltra is directed towards a method and apparatus for helping healthcare professionals create clinical protocols or assist in direct entry of the medical findings into a chart by intelligently prompting a healthcare professional with medical findings associated with one or more medical findings which has already been entered in the protocol (Abstract). Goltra further discloses that possible diagnosis are then ranked in descending point total and a predetermined plurality of the highest ranked diagnosis are selected (Abstract). The Examiner relies upon

Goltra to disclose providing the user interface step for ranking diagnosis codes linked with the procedure code in a user defined rank order (Office Action, page 6). Goltra provides a ranked list of diagnosis, however, this ranked number of diagnosis are computer generated based on the medical findings entered by the healthcare professional (col. 4, line 58-col. 5, line 31). Claim 84 has been clarified to make clear that the user is providing the rank ordering of the diagnosis codes. Claim 84 now requires "allowing the order of codes to be changed by the user by highlighting one of the codes and then moving the highlighted one of the codes either up or down". Support for this amendment is clear from the specification as originally filed, including at least at page 22, lines 5-10. Thus, claim 84 is clearly distinguished from the cited prior art, including Goltra.

Therefore, it is respectfully submitted this rejection to claim 84 must be withdrawn. As claims 88-89 and 94 depend from claim 84, it is respectfully submitted that this rejection must also be withdrawn. Claims 94-97 depend from claim 84 and claims 95-97 have been cancelled, thereby mooted those rejections.

Independent claim 98 has been amended to include the limitation of "receiving a change in ordering of diagnosis codes, the change in ordering performed by a user highlighting one of the codes and moving the one of the codes highlighted up or down within a user defined rank order list". Therefore, it is respectfully submitted that claim 98 is also distinguished from the cited prior art. Claims 99, 100, 102, 103 depend from claim 98, therefore, it is respectfully submitted that all these rejections should be withdrawn.

Independent claim 105 has been amended in a manner similar to claims 98 and 84, therefore, it is respectfully submitted the rejections to these claims should be withdrawn as well.

Since claims 108 and 110 depend from claim 105, it is respectfully submitted that these rejections should be withdrawn as well.

Claims 85-87 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Waters et al., Dorne, and Goltra as applied to claim 84, and further in view of U.S. Patent No. 5,772,585 to Lavin et al. In particular, claims 85-87 depend from claim 84. The rejection to claim 84 is deficient for the reasons previously expressed with respect to Dorne, Waters and Goltra. Lavin does not remedy these deficiencies. Therefore, it is respectfully submitted that these rejections should also be withdrawn.

Claims 92-93 and 105-109 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,393,404 to Waters et al, in view of U.S. Patent No. 5,823,949 to Goltra. Claims 92 and 105 have been amended. It is respectfully submitted that claims 92-93 and 105-109 as amended distinguish over both Waters and Goltra for the reasons previously expressed.

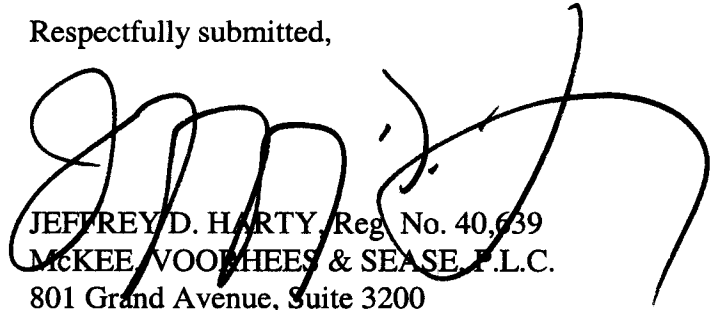
## **Conclusion**

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

In the event that the Examiner does not find all claims in proper form for immediate allowance, the Examiner is invited and encouraged to contact the undersigned attorney to arrange for a telephonic or in person interview to assist in advancing prosecution of the case.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,

A large, stylized handwritten signature in black ink, appearing to read 'J. Harty', is written over the printed name and firm information.

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